



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,002	08/16/2005	Richard Wade	2859-1-001PCT/US	9394
23565	7590	11/03/2009		
KLAUBER & JACKSON 411 HACKENSACK AVENUE HACKENSACK, NJ 07601			EXAMINER MAZUMDAR, SONYA	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			11/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/520,002	Applicant(s) WADE, RICHARD
Examiner SONYA MAZUMDAR	Art Unit 1791

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1, 2 and 5-15.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) _____.
 13. ☒ Other: "Prior to release of the said label from the web" would require further consideration/search, and a possible new rejection.

/Philip C Tucker/
 Supervisory Patent Examiner, Art Unit 1791

Continuation of 11, does NOT place the application in condition for allowance because:

Claims 1, 2, and 5-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as claim 1 recites the limitation "the said protruding leading edge" in line 14. Although line 8 discloses that the "leading edge (42A)" (is caused to) "protrude" out of the plane of the web", for the sake of consistency, the limitation in line 14 should refer back to a "protruding leading edge" or the limitation should be changed to "the leading edge", as it is the only leading edge referred to in the claim.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Boreali teaches a method of separating linerless, adhesive labels on a single layer label matrix web (17), where labels (11), with an adhesive surface (14) and an opposing release surface (13), are disposed at spaced intervals. The label boundaries are defined in the web by lines of cutting passing through the web, leaving the defined label connected to the remainder of the web by catch points (12). To remove the labels, the web is fed around a guide member (22), without damaging the label and such that the adhesive surface of the label does not face the guide. The leading edge of each label protrudes out of the plane of the web and this protruding edge forms a means whereby the remainder of the label can be extracted from the web by breaking the catch points (column 3, column 4, lines 12-24; Figures 4 and 5). On a side note, multiple catch points may be provided around each label, depending on the configuration, so all catch points will not be broken until the label is fully removed from the web (column 3, lines 53-61). However, there is no specific teaching of placing the labels directly onto the surface of a product container. Bekker-Madsen (US 5,112,427) teaches a method of applying adhesive labels (8) to products (13) directly after separating the labels from a backing material (9) (column 2, lines 53-65; column 3, lines 7-14; Figure 1).

Applicant argues that Boreali and Bekker-Madsen teach that a positive, controlled action is required to be performed using additional apparatus provided either via the rollers or cutting mechanism, to free the leading label and it is only after this has been done that the leading label can then be applied to the product or placed on the conveyor. However, as stated in previous actions, claim 1 discloses using an applicator of "the same function and operation as the conventional beak of conventional application machinery" (lines 5 and 6). Thus, it would have been obvious to one having ordinary skill in the art to place adhesive surfaces of labels provided on a single web onto a product, to avoid extra costs of a separate backing material (Bekker-Madsen: column 1, lines 30-53; Figure 1).

Applicant argues Bekker-Madsen always suggests moving the freed label to a labelling position, never directly to the container. As Applicant admits, Bekker-Madsen does teach that the labels are severed from their web and are then in position for attachment to a product (column 5, lines 32-36). Figure 1 of Bekker-Madsen clearly shows placement of a label onto a surface after being separated from a backing web. Therefore, it would have been obvious to one having ordinary skill in the art to apply labels to products directly after separating the labels from a backing material. Applicant also argues that in view of Bekker-Madsen, it would be impossible to move a pressure sensitive matrix with a beak on the adhesive side of the label. However, Bekker-Madsen teaches applying or activating adhesive after the label is exposed and separated from a backing web (column 2, lines 66-68). Bekker-Madsen further teaches that the strip of labels can also be moved forward continuously instead of in cycles; the release of labels on to to the goods can also be arranged differently, and , the strip of labels can also be made of a different labelling material, and it may be coated on the reverse with a layer of adhesive, which is at first inactive and is then adhesion-actuated when the individual labels are released into the labelling position (column 7, line 61 - column 8, line 5).

Applicant argues that the claimed method imposes no such size limitation on either the shape of the labels, or the size of the connections between adjacent label units. However, no such limitations are presently claimed.

Thus, the rejections are maintained in view of Boreali and Bekker-Madsen.